

This Opinion is Not a  
Precedent of the TTAB

Mailed: May 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Daniel Novela*

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Serial No. 90134566

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Daniel Novela, Novela Law Firm, P.A., pro se.

Christina L. Martin, Trademark Examining Attorney, Law Office 103,  
Stacy Wahlberg, Managing Attorney.

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Before Lykos, Greenbaum, and Johnson,  
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

Daniel Novela (“Applicant”) seeks registration on the Principal Register of the standard character mark CASA DE NOVELAS<sup>1</sup> (“Applicant’s Mark”) for goods initially identified as “Eyewear retainers; Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefor,” in International Class 9.

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<sup>1</sup> Application Serial No. 90134566, filed on August 25, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant’s claim of first use anywhere and first use in commerce since at least as early as April 4, 2017. The application includes the following translation statement: “The English translation of CASA DE NOVELAS in the mark is HOUSE OF STORIES.” Applicant disclaims the exclusive right to use the word “CASA.”

The Trademark Examining Attorney refused registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's Mark, as used in connection with Applicant's Goods, so resembles the mark NOVELLA<sup>2</sup> ("Registered Mark" or "Registrant's Mark"), registered on the Principal Register for "Ophthalmic lenses for eyeglasses" in International Class 9, as to be likely to cause confusion or mistake, or to deceive.

When the refusal was made final, Applicant requested reconsideration, arguing against the refusal and amending the identification of goods to "Fashion sunglasses, excluding prescription lenses," in International Class 9 ("Applicant's Goods") in order to overcome the refusal. The Examining Attorney accepted the amendment but also issued a subsequent final refusal. Thereafter, Applicant filed a Notice of Appeal. The appeal has been fully briefed. We affirm the refusal to register.

### **I. Likelihood of Confusion**

Section 2(d) of the Trademark Act provides that a mark must be refused registration if it "[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office ... as to be likely, when used on or in

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<sup>2</sup> Registration No. 3881077, issued November 23, 2010; renewed.

Citations to the appeal record are from the publicly available documents in TTABVUE, the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable.

Citations to the application record are from downloadable .pdf versions of the documents in the Trademark Status and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO).

connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive ... .” 15 U.S.C. § 1052(d).

To determine whether there is a likelihood of confusion between the marks under Section 2(d), we analyze the evidence and arguments under the *DuPont* factors. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1161-62 (Fed. Cir. 2019). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. ... Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at \*3 (Fed. Cir. 2020). “In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*29 (TTAB 2021) (citing *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)).

#### **A. The Similarity or Dissimilarity and Nature of the Goods**

The second *DuPont* factor concerns the “similarity or dissimilarity and nature of the goods or services as described in an application or registration ... .” *DuPont*, 177 USPQ at 567. When analyzing the second *DuPont* factor, we look to the identifications of goods in the application and cited registration. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); *Stone Lion Capital*

*Partners v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014); see *Octocom Sys., Inc. v. Hous. Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.”). The goods do not have to be identical or even competitive in order to find that there is a likelihood of confusion. *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009).

The issue is not whether the goods will be confused with each other, but rather whether the public will be confused as to their source. See *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) (“[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.”). It is sufficient that the identified goods of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source. See, e.g., *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (citation

omitted); *On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000).

Evidence of relatedness may include pages from third-party websites showing that the relevant goods are used by purchasers for the same purpose, advertisements showing that the relevant goods are advertised together, or copies of use-based registrations of the same mark for both the applicant's identified goods and the goods listed in the cited registrations. *See, e.g., In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014) (finding pepper sauce and agave related where evidence showed both were used for the same purpose in the same recipes because consumers were likely to purchase the products at the same time and in the same stores).

Applicant argues generally that his goods are "dissimilar" from Registrant's Goods, and that a consumer encountering Applicant's and Registrant's goods would not assume that the goods originate from the same source. (2 TTABVUE 8). On the other hand, the Examining Attorney argues that the "fashion sunglasses, excluding prescription lenses" offered under Applicant's Mark, and the "ophthalmic lenses for eyeglasses" offered under Registrant's Mark, are related. In support of her argument, the Examining Attorney made of record the following third-party use-based registrations<sup>3</sup> showing the registration of "fashion sunglasses" and "ophthalmic lenses for eyeglasses" or the equivalent thereof, under the same mark.

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<sup>3</sup> Feb. 23, 2021 Final Office Action at 26-42.

<u>Reg. No.</u>	<u>Reg. Mark</u>	<u>Relevant International Class 9 Goods</u>
4228204		Eyewear, namely, sunglasses; ophthalmic lenses; sunglass lenses; eyewear cases.
3622233	PRO-TOUR	Eyewear, namely, prescription eyeglasses, eyeglass frames, non-prescription sunglasses, prescription sunglasses, reading glasses; ophthalmic lenses, namely, prescription lenses, non-prescription lenses, non-prescription sun lenses, prescription sun lenses, tinted lenses, polarized lenses; prescription and non-prescription ophthalmic and sunglass lenses featuring mirror coatings, anti-fog coatings, anti-reflective coatings, scratch resistant coatings; magnetic eyewear, namely, auxiliary sunglass and ophthalmic lenses that attach to a pair of eyeglasses by means of magnets; eyewear accessories, namely, eyeglass cases, sunglass cases.
5896755		Cases for spectacles, for pince-nez and for contact lenses; Contact lenses; Containers for contact lenses; Eyeglass cases; Eyeglass chains; Eyeglass cords; Eyeglasses; Pince-nez; Pince-nez chains; Pince-nez cords; Pince-nez mountings; Spectacle cases; Spectacle frames; Spectacle lenses; Spectacles; Sunglasses; Ophthalmic lenses.
6240490	BLUMAX	Lenses of all kinds, namely, ophthalmic lenses, spectacle lenses, contact lenses; optical accessories, namely, optical frames; spectacles; spectacle cases; parts, fittings, components of the aforesaid goods, namely, optical frames; sunglasses.
6229013	MIND EYE BRAINWEAR  ("eye" disclaimed)	Eyewear; Eyewear cases; eyewear, namely, tinted and occluded lenses and prisms for neurologic and/or sensory effect; Lenses for sunglasses; Anti-reflective lenses; Contact lenses; Eyeglass frames; Eyeglass lenses; Ophthalmic lenses; Optical frames.

6179801		3D spectacles; Contact lens cases; Contact lenses; Eye glasses; Eyeglass cases; Eyeglass frames; Lenses for sunglasses; Ophthalmic lenses; Pince-nez; Sun glasses.
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The Examining Attorney also made of record pages from the third-party websites listed below, at which “fashion sunglasses, excluding prescription lenses” and “ophthalmic lenses for eyeglasses” are offered under the same mark:

- Archibald London, [Archibaldlondon.com/us](http://Archibaldlondon.com/us);<sup>4</sup>
- Costa, [costadelmar.com/en-us](http://costadelmar.com/en-us);<sup>5</sup>
- Liingo Eyewear, [liingoeyewear.com](http://liingoeyewear.com);<sup>6</sup>
- Oakley, [oakley.com/en-us](http://oakley.com/en-us);<sup>7</sup>
- Warby Parker, [warbyparker.com](http://warbyparker.com);<sup>8</sup>
- Ray-Ban, [ray-ban.com/usa](http://ray-ban.com/usa);<sup>9</sup>
- Roka, [roka.com](http://roka.com);<sup>10</sup> and
- Tifosi, [tifosioptics.com](http://tifosioptics.com).<sup>11</sup>

As a general proposition, third-party registrations that cover goods from both the cited registration and an applicant’s application are relevant to show that the goods

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<sup>4</sup> Dec. 28, 2020 Office Action at 6-10.

<sup>5</sup> *Id.* at 13-18.

<sup>6</sup> *Id.* at 19-22.

<sup>7</sup> *Id.* at 23-27.

<sup>8</sup> *Id.* at 28-32.

<sup>9</sup> Feb. 23, 2021 Final Office Action at 14-17.

<sup>10</sup> *Id.* at 18-22.

<sup>11</sup> Apr. 9, 2021 Final Office Action at 6-7.

are of a type that may emanate from a single source under one mark. *See, e.g., Detroit Athletic*, 128 USPQ2d at 1051; *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Infinity Broad. Corp. of Dall.*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Although the third-party registrations are not evidence that the registered marks are actually in use or that the public is familiar with them, particularly in the absence of any evidence showing the extent of their use, we weigh whatever probative value they have in conjunction with the third-party website evidence submitted by the Examining Attorney. *See Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) (citation omitted); *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 462-63 (CCPA 1973); *In re Midwest Gaming & Entm't*, 106 USPQ2d 1163, 1167 n.5 (TTAB 2013); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1207.01(d)(iii) (July 2021).

In addition, the Examining Attorney made of record pages from the third-party websites listed below, demonstrating that sunglasses generally and ophthalmic lenses (commonly known as prescription lenses) are complementary goods that are often used together.

- Maui Jim, [mauijim.com/US](http://mauijim.com/US);<sup>12</sup>
- Zeal Optics, [zealoptics.com/US](http://zealoptics.com/US);<sup>13</sup>
- WileyX, [wileyx.com](http://wileyx.com);<sup>14</sup>
- RX Safety, [rx-safety.com](http://rx-safety.com);<sup>15</sup> and
- Shadesdaddy, [shadesdaddyblog.com](http://shadesdaddyblog.com).<sup>16</sup>

Complementary use of goods is recognized as a relevant consideration in determining a likelihood of confusion. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984) (bread and cheese are related because they are often used in combination); *In re Vienna Sausage Mfg. Co.*, 230 USPQ 799, 799-800 (TTAB 1986) (sausage and cheese are related because they are complementary goods that may be used together in recipes, sandwiches, and hors d'oeuvres); *Polo Fashions, Inc. v. La Loren, Inc.*, 224 USPQ 509, 511 (TTAB 1984) (bath sponges and personal products such as bath oil, soap, and body lotion, are related because they are complementary goods that are likely to be purchased and used together by the same purchasers).

The evidence of record in this case shows that Applicant's Goods and Registrant's Goods are manufactured, produced, or provided by the same source, and are marketed to the same consumers — here, ordinary consumers of ophthalmic lenses for

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<sup>12</sup> Feb. 23, 2021 Final Office Action at 10-13.

<sup>13</sup> *Id.* at 23-25.

<sup>14</sup> Apr. 9, 2021 Final Office Action at 8-9.

<sup>15</sup> *Id.* at 10.

<sup>16</sup> *Id.* at 11.

eyeglasses and ordinary consumers of non-prescription fashion sunglasses — under the same marks at the same web sites. Furthermore, the goods are complementary. As a result, we find all of the aforementioned third-party evidence to be highly probative of relatedness. This *DuPont* factor weighs in favor of a finding of likelihood of confusion.

**B. Established, Likely-to-Continue Channels of Trade**

The third *DuPont* factor is the similarity or dissimilarity of established, likely to continue channels of trade. Because Applicant's and Registrant's identifications contain no restrictions as to channels of trade or classes of purchasers, we must presume that the identified goods travel in the ordinary channels of trade for such goods. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003).

Applicant contends that confusion is unlikely because the goods at issue are advertised, distributed, and sold through distinct trade channels. (2 TTABVUE 9). Specifically, Applicant states that his goods are marketed through fashion boutiques, department stores, and his own e-commerce platform, but speculates that Registrant's Goods are likely only available for purchase at the offices of optometrists and ophthalmologists, or through the Internet. (2 TTABVUE 9). Applicant further speculates that the "average consumer may never even know that it [sic] has purchased a Novella lens." (2 TTABVUE 10).

Determining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic*, 128 USPQ2d at 1052 (citing *In re i.am.symbolic, LLC*, 866

F.3d 1315, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). Here, the application and registration are unrestricted as to channels of trade or classes of purchasers, so we must presume that the average consumer would encounter both Applicant's and Registrant's goods in the ordinary trade channels for such goods. Although Registrant's Goods are "ophthalmic lenses for eyeglasses" and Applicant's fashion sunglasses specifically exclude prescription lenses, the previously-discussed website evidence offered by the Examining Attorney definitively supports the finding that consumers would encounter both Applicant's and Registrant's goods in the same trade channels, inasmuch as Costa, Oakley, Warby Parker, and Tifosi offer both "ophthalmic lenses for eyeglasses" and fashion sunglasses — with prescription or non-prescription lenses — to the same consumers through online and brick-and-mortar channels of trade. The Examining Attorney's evidence demonstrating complimentary use of the goods further supports that finding, inasmuch as Maui Jim, Zeal Optics, and Wiley X offer all types of prescription and non-prescription sunglasses, including fashion sunglasses, to the same consumers, also through online and brick-and-mortar channels of trade. Based on the evidence, we find that Applicant and Registrant offer their respective goods to the same consumers in the same channels of trade. Thus, the third *DuPont* factor favors a finding of likelihood of confusion.

### **C. The Similarity or Dissimilarity of the Marks**

Next we consider the *DuPont* factor relating to the similarity or dissimilarity of the marks. In comparing the marks we must consider their appearance, sound,

connotation and overall commercial impression in their entireties. *DuPont*, 177 USPQ at 567. Similarity as to any one of these factors may be sufficient to support a finding that the marks are confusingly similar. *See In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (“Similarity in any one of these elements may be sufficient to find the marks confusingly similar.”), *aff'd mem.*, 777 F. App'x 516 (Fed. Cir. Sept. 13, 2019) (quoting *In re Davia*, 110 USPQ2d at 1812); *Krim-Ko Corp. v. Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”);

“The proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic*, 123 USPQ2d at 1748 (quoting *Coach Servs.*, 101 USPQ2d at 1721); *see also In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (“[M]arks must be considered in light of the fallibility of memory and not on the basis of side-by-side comparison.”). Our analysis must focus on the recollection of the average purchaser — here, an ordinary consumer of ophthalmic lenses for eyeglasses and an ordinary consumer of non-prescription fashion sunglasses — who normally retains a general, rather than specific, impression of trademarks.

There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, such as a common dominant element,

provided the ultimate conclusion rests on a consideration of the marks in their entireties. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant argues that the marks are distinct in appearance, sound, meaning, and overall commercial impression. Applicant asserts that his three-word Spanish language mark, CASA DE NOVELAS, is in the “possessive form,” with “DE” meaning “of” in English, and that the last element, “NOVELAS,” is plural and spelled with one “L” instead of two. (2 TTABVUE 5). As to sound, Applicant asserts that his mark is only pronounced “CAH-SA—DE—NO-VE-LAS,” but Registrant’s Mark could be pronounced in a “number of different ways.” (2 TTABVUE 5). Applicant also asserts that the connotation of his mark completely distinguishes it from Registrant’s Mark, because CASA DE NOVELAS “is a play on words of Applicant’s surname, Novela.” (2 TTABVUE 6). Applicant is of the opinion that consumers specifically seek out Applicant’s hand-made Italian garments and fashion sunglasses “based on [their] connection to Applicant, **Mr. Daniel Novela.**” (2 TTABVUE 6) (emphasis in original).

Moreover, Applicant contends that the commercial impressions of the marks are distinguished when Applicant’s Mark is used with Applicant’s house mark,



,<sup>17</sup> and Registrant’s house mark, VISION EASE, is used with the Registered Mark, NOVELLA. (2 TTABVUE 7).

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<sup>17</sup> Reg. No. 4702880 in International Class 25 for “Men’s and Women’s clothing apparel, namely, blazers, suits, sport coats, fur and leather jackets, shirts, pocket squares, scarves,

We find, however, that the marks at issue here are similar in sound, appearance, connotation, and overall commercial impression. As noted above, for rational reasons, we may give more or less weight to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entirety. *In re Viterra*, 101 USPQ2d at 1908.

Applicant's Mark and Registrant's Mark are both standard character marks that share one nearly identical element and have similar connotations. NOVELLA, for which no translation is provided in the registration, means "short story" in English.<sup>18</sup> Applicant asserts that his mark is a play on his last name,<sup>19</sup> but the record also establishes that Applicant provided an English translation for CASA DE NOVELAS as "house of stories." "CASA" is disclaimed.

As to the minor differences between "NOVELLA" and "NOVELAS," singular and plural marks are essentially identical in sound, appearance, meaning, and commercial impression. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2011 n.17 (TTAB 2015) ("it is obvious that the virtually identical marks [SWISS GRILL composite mark and SWISS GRILLS] are confusingly similar") (citing *Wilson v. DeLaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957) ("there is no material difference, in a trademark sense, between the singular and plural forms of the word

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t- shirts, tank tops, blouses, sweaters, sweatshirts, shorts, jeans, pants, sweatpants, dresses, skirts, hats, footwear, belts, suspenders, gloves, socks, neckties, bow ties, ascots, undergarments and swimwear." Combined Sections 8 and 15 declaration accepted and acknowledged.

<sup>18</sup> Feb. 23, 2021 Final Office Action at 9.

<sup>19</sup> See Jan. 2, 2021 Response to Office Action at 20.

‘Zombie’)); *Weider Publ’ns, LLC v. D & D Beauty Care Co.*, 109 USPQ2d 1347, 1355 (TTAB 2014) (holding SHAPES for a variety of beauty salon, day spa, and health spa services likely to cause confusion with SHAPE for magazines where the services were of the type normally featured in the magazines), *appeal dismissed per stipulation*, No. 2014-1461 (Fed. Cir. Oct. 10, 2014).

Considering the remaining elements of Applicant’s Mark, “NOVELAS” is clearly the dominant element. “DE,” which serves as a preposition, does not create a distinct commercial impression; marks may be confusingly similar in appearance despite the addition, deletion, or substitution of letters or words. *See, e.g., Weiss Assocs. Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) (finding TMM confusingly similar to TMS); *In re Lamson Oil Co.*, 6 USPQ2d 1041 (TTAB 1987) (finding TRUCOOL and TURCOOL confusingly similar in appearance); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (finding MILTRON and MILLTRONICS (stylized) to be highly similar in appearance). “CASA,” the first element of Applicant’s Mark, is granted only very slight weight because it is disclaimed. Descriptive or disclaimed matter is often “less significant in creating the mark’s commercial impression,” *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001), and may be given little weight. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000). *See also In re Detroit Athletic*, 128 USPQ2d at 1050 (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)).

Contrary to Applicant's assertion, we also find that "NOVELLA" and "NOVELAS" could be pronounced similarly. Such similarity in sound alone may be sufficient to support a finding that the compared marks are confusingly similar. *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp.*, 156 USPQ at 526). However, there is no truly correct pronunciation of an entire mark; thus, consumers may pronounce a mark differently than intended by the mark owner. *See In re Viterra*, 101 USPQ2d at 1912 (citing *Interlego AG v. Abrams/Gentile Entm't, Inc.*, 63 USPQ2d 1862, 1863 (TTAB 2002)).

Next we turn to Applicant's assertion that house mark use by both Applicant and Registrant obviates any likelihood of confusion between the marks. First, we note that Registrant's Mark, NOVELLA, is registered independently of any house mark, despite how Registrant's Mark may be used at Registrant's web site.<sup>20</sup> As to Applicant's Mark, there is no limitation in the application indicating that the word mark is only to be used with Applicant's so-called registered house mark,



. In any case, generally, "use of a house mark does not obviate confusion." *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1965 (TTAB 2016) (citing *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ 1584, 1602 (TTAB 2011); *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1364 (TTAB 2007)). And although the phrase "Casa De Novelas" is the literal element of Applicant's registered

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<sup>20</sup> See Jan. 2, 2021 Response to Office Action at 30-33.

composite “house mark,” the application to register CASA DE NOVELAS is for a separate standard character mark without the word “MIAMI” or a floral design, despite how Applicant’s Mark may appear on his social media site.<sup>21</sup> As previously discussed, our analysis is confined to the marks as they appear in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic* 128 USPQ2d at 1052 (citing *In re i.am.symbolic*, 123 USPQ2d at 1749).

On balance, the similarities of the marks outweigh the dissimilarities resulting from the slight differences in the spelling of “CASA DE NOVELAS” and “NOVELLA,” and the association of the CASA DE NOVELAS mark with the founder of the business, Mr. Daniel Novela. Considering the marks in their entirety, the marks are similar in appearance, sound, meaning, and overall commercial impression. Thus, this *DuPont* factor weighs in favor of a finding of likelihood of confusion.

#### **D. Length of Time of Concurrent Use Without Actual Confusion**

Next, we address Applicant’s argument that confusion is unlikely because there has been no actual confusion. (2 TTABVUE 10-11). Under the eighth *DuPont* factor, we consider “the length of time during and conditions under which there has been concurrent use without evidence of actual confusion.” *In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at \*6 (TTAB 2020) (quoting *DuPont*, 177 USPQ at 567). In *Guild Mortg.*, the Board held that unlike other *DuPont* factors, the eighth factor “requires

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<sup>21</sup> *See id.* at 15-19.

us to look at **actual market conditions**, to the extent there is evidence of such conditions of record.” *Id.* at \*6 (emphasis in original).

However, “[u]ncorroborated statements of no known instances of actual confusion . . . are of little evidentiary value,” especially in ex parte examination. *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). Here, Applicant’s statement of no known instances of actual confusion is uncorroborated. Due to the absence of any argument or evidence, the eighth *DuPont* factor is neutral.

**E. The Extent to Which Applicant Has a Right to Exclude Others from Use of His Mark on His Goods**

Finally, we turn to Applicant’s “zone of natural expansion” argument, which falls under the eleventh *DuPont* factor. “The extent to which applicant has a right to exclude others from use of its mark on its goods’ is listed as the eleventh factor in the *du Pont* decision.” *McDonald’s Corp. v. McSweet, LLC*, 112 USPQ2d 1268, 1284-85 (TTAB 2014) (quoting *DuPont*, 177 USPQ at 567).

Typically, the zone of natural expansion doctrine is applied in inter partes proceedings where an opposer claims that its priority of use of a mark with respect to its goods should be extended to include applicant’s goods because they are in the natural scope, or zone, of expansion of opposer’s goods. *See Orange Bang, Inc. v. Olé Mexican Foods, Inc.*, 116 USPQ2d 1102, 1119 (TTAB 2015); *In re 1st USA Realty Prof’ls*, 84 USPQ2d at 1584 (referring to the “expansion of trade doctrine”). However, in ex parte proceedings, the doctrine has limited application:

Obviously if there is evidence that **third parties** offer both types of goods or services, that indicates that an entity could expand its business to include both types of goods or

services. It is also evidence that the public would believe that both types of goods or services emanate from a single source. **It is not necessary, however, in the context of an ex parte proceeding, for the Office to show that the owner of the particular registration that has been cited against the application has expanded or will expand its goods or services.**

*Id.* at 1584 n.4 (emphasis added); *see also In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1266 (TTAB 2011); TMEP § 1207.01(a)(v). In the ex parte context, a normal relatedness analysis is applied when the zone of natural expansion is asserted:

[W]e look at the question of the relatedness of the [goods] **identified in applicant’s application and those in the cited registration** based on whether consumers are likely to believe that the [goods] emanate from a single source, rather than whether the Examining Attorney has shown that the registrant . . . has or is likely to expand its particular business to include the [goods] of applicant.

*In re 1st USA Realty Prof’ls*, 84 USPQ2d at 1584 (emphasis added). In short, to the extent the zone of natural expansion does apply in ex parte cases, it “is considered through a traditional relatedness of goods and services approach.” *Id.* at 1584 n.4.

Applicant asserts that:

**Applicant’s Mark is also within the natural scope of expansion of the Applicant’s Registered Mark.** This “expansion-of-trade” doctrine may be used in a situation such as the present case, where a company is already using their trademark in one area, and the newly expanded area is a natural extension of the prior use. *See* TMEP 1207.01(a)(v). Here, the Applicant’s has expanded its use of the Applicant’s Registered Mark (CASA DE NOVELAS MIAMI) in connection with clothing, to using the “Casa de Novelas” mark and trade name in connection with the Applicant’s Goods, as set forth in the present application, **as amended together herewith.** This expansion is within a zone of natural expansion for Applicant’s clothing business. Accordingly, consumers should believe that Applicant’s Goods, which are marketed and sold in

connection with Applicant's Mark, emanate from the same source (here, the Applicant) as those goods marketed and sold under Applicant's Registered Mark.

2 TTABVUE 11-12 (emphasis added to first sentence). Applicant misconstrues how the zone of natural expansion is applied, particularly in ex parte cases, and thus fails in his evidentiary burden of proof. Consequently, this *DuPont* factor is neutral.

## **II. Conclusion**

Balancing all of the relevant likelihood of confusion factors, we find that confusion is likely between Applicant's Mark, CASA DE NOVELAS, for "Fashion sunglasses, excluding prescription lenses," in International Class 9, and Registrant's Mark, NOVELLA, given the related goods, overlapping classes of purchasers and trade channels, and the similarities of the marks in sound, appearance, connotation, and overall commercial impression.

**Decision:** The refusal to register Applicant's Mark, CASA DE NOVELAS, in International Class 9 for "Fashion sunglasses, excluding prescription lenses," is affirmed under Trademark Act Section 2(d) on the ground of likelihood of confusion.